

REMARKS

Claims 1-8 were pending in this Application as of the Office action of January 9, 2008. Claims 1, 5, 6, and 8 are amended with this Response, and claims 3, 4, and 7 are cancelled.

Rejections under 35 U.S.C. 102(b)

Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by the Protag Systems Inc. website (Protag hereinafter). Applicant respectfully traverses.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant’s amended claim 1 recites *inter alia*,

“recording the document as an image and presenting the image to an operator when the document is rejected as negatively authenticated.”

Protag does not teach a recording of a document as an image, and a presenting of the image to an operator, when the document is rejected as negatively authenticated. Instead, the Protag system is taught to simply reject any non-authenticated documents. In the Protag system such non-authenticated documents include documents that may be valid, but are merely damaged or spoiled. This falls short of Applicant’s method, which allows an operator to determine whether the rejected document image is still valid even though it is damaged or spoiled. Viewing of this image offers an additional verification step over that taught by Protag, which results in higher reliability.

For at least the above reasons, Applicant respectfully asserts that Protag does not

teach every element of Applicant's claim 1, or claims 2 and 5-6 that depend therefrom (claims 3, 4, and 7 are cancelled). As such, it is respectfully submitted that Applicant's claims 1-2 and 5-6 are not anticipated by Protag.

Claim Rejections Under 35 U.S.C. §103

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable Protag in view of Official Notice. Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 5 depends from claim 1. Thus, for at least the reasons discussed above, Applicant respectfully asserts that Protag does not teach or suggest all of the limitations of Applicant's claim 5. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 5 with respect to Protag.

Since Protag does not teach every element of Applicant's claim 5, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify Protag, or a reasonable likelihood of success in forming the claimed invention by modifying Protag. Thus, here again, *prima facie* obviousness does not exist. *Id.*

As such, the requirements of *prime facie* obviousness does not exist regarding claim 5 with respect Protag.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Protag in view of In Re Harza. Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant's amended claim 1 recites *inter alia*,

“a recording station for the document, the recording station being configured to provide an image and present the image to an operator when the document is authenticated negatively because a probability of authenticity does not meet predetermined criteria.”

Protag does not teach a recording station for recording document as an image, and presenting the image to an operator when the document is authenticated negatively. Instead, as discussed with regards to claim 1 above, the Protag system is taught to simply reject any non-authenticated documents. Thus, Applicant respectfully asserts that Protag does not teach or suggest all of the limitations of Applicant's claim 8. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 8 with respect to Protag.

Since Protag does not teach every element of Applicant's claim 8 one of ordinary skill at the time of Applicant's invention would not have a motivation to modify Protag, or

a reasonable likelihood of success in forming the claimed invention by modifying Protag. Thus, here again, *prima facie* obviousness does not exist. *Id.*

As such, the requirements of *prime facie* obviousness does not exist regarding claim 8 with respect Protag.

Conclusion

Applicant hereby petitions under 37 C.F.R. §1.136 for any extension of time required for entry and consideration of this submission.

The Office is invited to contact Applicant's attorneys at the below-listed telephone number concerning this Submission or otherwise regarding the present application.

If there are any charges with respect to this Submission, or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,
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